Paper No. 35

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FUJIO NOGUCHI, KAZUHIKO AKAIKE,
SETSUKO W. BLASZKOWSKI, NORIKO KOTABE,
TAKASHI OTANI and TADASHI KAJIWARA

Appeal No. 1999-0155
Application 08/369,676

ON BRIEF

Before URYNOWICZ, FLEMING and LALL, Administrative Patent Judges.

LALL, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the final rejection of claims 32, 34-37 and 39-41, the only remaining claims in the application.

The invention is directed to a multiple channel broadcasting system wherein the pressing of a guide button on

the remote control device provides an electronic programming guide. Figure 15 of the specification is an example of an electronic programming guide in accordance with the teachings of the presently claimed invention. This system tunes to the station at which a pointer of the electronic programming guide is located and provides the audio and video, wherein the electronic program guide is superimposed over the video. Furthermore, the system displays programming description information in the electronic program guide. When the user moves the pointer to a different station, the system automatically tunes to the new station at which the pointer is located and provides the auto, video, and a program description. Therefore, the user can preview many different stations without repeatedly entering and exiting the program guide. A further understanding of the invention can be obtained by the following claim.

32. In a multiple channel broadcasting system in which programs are broadcasted for display on a screen, a method for generating an on-screen favorite station guide for a user to select favorite channels to view, comprising the steps of:

selecting at least one channel as the user's favorite channel;

tuning to a first channel to provide a broadcast of a

first program on the screen;

generating a favorite station guide, said favorite station guide consisting of an array of favorite stations, each array element providing a selectable area identifying the channel number, station identification and title of currently broadcasted program of each favorite station;

superimposing the favorite station guide over the broadcast on the screen, such that only a portion of the video of the broadcast is covered by the displayed favorite station guide and the audio is broadcasted;

moving a system pointer displayed on the screen to point to a selectable location on the displayed station guide to point to a second program currently broadcasted on a favorite station on a second channel; and

tuning to the second channel to provide a broadcast of the second program on the screen in response to the movement of the pointer.

The Examiner relies on the following references:

Marshall et al. (Marshall)	5,523,796	Jun. 4, 1996 (filed May 20, 1994)
Young et al. (Young)	5,532,754	Jul. 2, 1996 (effectively filed Oct. 30, 1989)
Florin et al. (Florin)	5,594,509	Jan. 14, 1997 (filed June 22, 1993)

Claims 32, 34-37 and 39-41 stand rejected under 35 U.S.C. § 103 as being unpatentable over Florin in view of Young and

Marshall.

Rather than repeat the positions and the arguments of Appellants and the Examiner, we make reference to the briefs[1] and the answer for the respective positions.

OPINION

We have considered the rejections advanced by the Examiner. We have, likewise, reviewed Appellants' arguments against the rejections as set forth in the briefs.

We reverse.

In our analysis, we are guided by the general proposition that in an appeal involving a rejection under 35 U.S.C. § 103, an Examiner is under a burden to make out a prima facie case of obviousness. If that burden is met, the burden of going forward then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness, is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See In re

[1] A reply brief was filed as Paper No. 25, and the Examiner entered it into the record without any further response, see Paper No. 26.

Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). We are further guided by the precedent of our reviewing court that the limitations from the disclosure are not to be imported into the claims. In re Lundberg, 244 F.2d 543,

113 USPQ 530 (CCPA 1957); In re Queener, 796 F.2d 461, 230 USPQ 438 (Fed. Cir. 1986). We also note that the arguments not made separately for any individual claim or claims are considered waived. See 37 CFR § 1.192(a) and (c). In re Baxter Travenol Labs., 952 F.2d 388, 391, 21 USPQ2d 1281, 1285 (Fed. Cir. 1991) ("It is not the function of this court to examine the claims in greater detail than argued by an Appellant, looking for nonobviousness distinctions over the prior art.");
In re Wiechert, 370 F.2d 927, 936, 152 USPQ 247, 254 (CCPA 1967)("This court has uniformly followed the sound rule that

an issue raised below which is not argued in that court, even of it has been properly brought here by reason of appeal is regarded as abandoned and will not be considered. It is our function as a court to decide disputed issues, not to create them.").

Analysis

At the outset, we note that the Appellants elect to have claims 32, 34-37 and 39-41 all stand or fall together, see brief at page 4.

We take claim 32 as representative of the group. The Examiner gives a detailed explanation of the rejection at pages 3-5 of the Examiner's Answer. The Examiner concludes, id. at page 5, that "[g]iven the systems of Young et al. and Marshall et al., a person having ordinary skill in the art would have readily recognized the desirability of displaying the electronic guide covering only a portion of the video of the broadcast, so that a user can follow the broadcast program

(by listening to the audio portion) while viewing the electronic program guide. Therefore, the claimed invention (claims 32 and 37) would have been a mere modification of the system disclosed by Florin et al."

Appellants argue that Florin, Young or Marshall, alone or in combination, do not disclose or suggest the claimed tuning to the second channel to provide a broadcast of the second program on the screen in response to the movement of the pointer. See pages 5-13 of the brief and pages 2-3 of the reply brief. Appellants also argue that the program guide shown by Marshall or Young is not of the same type as claimed because the information provided by the guide in Young or Marshall only pertains to a single channel.

Regarding the argument of Appellants that Young or Marshall do not show the type of program guide claimed by Appellants, we note that, to the extent claimed, a program guide covering a portion of the screen displaying a program is indeed shown by Marshall or Young. As to the type of information in the program guide, that is shown by Florin, see

for example Figure 12 of Florin. However, we do not agree with the Examiner's position, answer at page 7, that, "the teaching of Florin, at col. 18, line 61 to col. 19, line 3, satisfies the claimed limitations. Although the tuning to the second channel (Florin) is manual, the invention, as broadly claimed, does not preclude such an interpretation. It is further noted that the selection of the second channel is responsive to the moving of a pointer (highlighter)." Thus, we note that the Examiner admits that an additional (manual) step of pressing the selection button is required after the pointer has been pointed to a particular desired program, that accomplishes the tuning of the channel selected by movement of the pointer. The Examiner's argument seems to rely on his interpretation of the phrase "in response to". The Examiner seems to suggest that since the selection of

the second channel was performed by the movement of the pointer on the program guide display, any subsequent tuning of the selected second channel was in response to the movement of the pointer. However, we do not agree with this

interpretation of the phrase "in response to" in claim 32. We are of the view that the claimed limitation "tuning to the second channel to provide a broadcast of the second program on the screen in response to the movement of the pointer" requires that the second channel is tuned as the pointer is moved to the second channel without any additional step of pressing any other function key on the remote control. Therefore, we agree with Appellants that the combination of Florin, Young and Marshall does not satisfy the claimed limitation.

With respect to the other independent claim, 37, we note that this is an apparatus claim. It contains a limitation corresponding to the above limitation. Consequently, the combination of Florin, Marshall and Young does not meet the claim limitation "said system responding to the movement of the pointer to the selected location by tuning the second channel to provide a broadcast of a second program on the screen."

Therefore, we do not sustain the obviousness rejections

of claims 32, 34-37, and 39-41 over Florin, Young, and Marshall.

The decision of the Examiner rejecting claims 32, 34-37, and 39-41 under 35 U.S.C. § 103 is reversed.

REVERSED

STANLEY M. URYNOWICZ, JR. Administrative Patent Judge	)	
MICHAEL R. FLEMING Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
PARSHOTAM S. LALL Administrative Patent Judge	)	

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Blakely, Sokoloff, Taylor and Zafman
12400 Wilshire Boulevard
Seventh Floor
Los Angeles, CA 90025